

REMARKS

Claims 25, 26, 43-46 and 69-71 and 73 are pending.

No new matter has been added. For instance, claim 43 has been amended to include subject matter taken from claim 72. Claim 72 has been cancelled and the dependency of claim 73 has been altered. Additionally, claim 73 has been amended to clarify the language concerning the host microorganism. Accordingly, no new matter has been added.

Additionally, no new issues have been raised which would require additional search and/or consideration on the part of the Examiner. For instance, claim 43 has simply been amended to include textual subject matter taken from claim 72. Claim 72 is presumed to have already been properly considered, thus, the inclusion of such subject matter into claim 43 does not create a "new issue." Additionally, claim 73 has been amended to remove an issue under 35 U.S.C. § 112, second paragraph. Therefore, the Examiner has not been presented with the burden of additional search and/or consideration.

In the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 72 and 73 under 35 U.S.C. § 112, second paragraph for the reasons recited at page 2 of the outstanding Office Action. Applicants respectfully traverse.

The Examiner has asserted that claims 72 and 73 broaden the base claim 43. Applicants disagree and submit that the Examiner's interpretation is not reasonable. However, in an effort to further prosecution, Applicants have amended the relevant claim language to indicate that the host microorganism carries the recited genes. This is a non-narrowing amendment. In summary, this rejection is moot. Reconsideration and withdrawal thereof are respectfully requested.

Issues under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 43, 45, 46 and 69-71 under 35 U.S.C. § 112, first paragraph, for the reasons recited at pages 2-5 of the outstanding Office Action. Applicants respectfully traverse this rejection.

The Examiner asserts that claims 43, 45, 46 and 69-71 do not comply with "written description" and "enablement" requirements. In this regard, the Examiner asserts that the increase in yield of ethanol has only been accomplished with certain transformants. Applicants again stress that the Examiner has mischaracterized the transformants. For instance, the Examiner refers to H1803 (see page 3, last line and page 6, second to last line of the outstanding Office Action) as including XR and XDH. However, as explained at pages 29-30 of the present specification, H1803 does not include XR or XDH. Similarly, the Examiner has also incorrectly asserted that H1791 includes XR and XDH. Moreover, the Examiner has made similar mistakes with respect to the characterization of H2195 and H2222.

Regardless, Applicants have amended independent claim 43 to include the textual subject matter taken from claim 72. Since this claim was not included in the above rejections, the

inclusion of such subject matter in independent claim 43 renders these rejections moot. Reconsideration and withdrawal thereof are respectfully requested.


In summary, Applicants respectfully submit that the above remarks fully address and overcome the outstanding rejections. Accordingly, the Examiner is respectfully requested to withdraw all outstanding rejections and allow the currently pending claims.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By  #42.874
Gerald M. Murphy, Jr.
Registration No.: 28,977
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant